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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,531	07/13/2006	Ray Davenport	205666-5040-00-US(455390)	4385

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DRINKER BIDDLE & REATH
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EXAMINER

GREEN, ANTHONY J

ART UNIT	PAPER NUMBER
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1731

NOTIFICATION DATE	DELIVERY MODE
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05/16/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DBRIPDocket@dbr.com
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Office Action Summary

Application No.

10/552,531

Applicant(s)

DAVENPORT ET AL.

Examiner

Anthony J. Green

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-7,9,10 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,9,10 and 12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment submitted on 13 April 2011. After entry of the amendment claims 1, 4-7, 9-10, 12-20 are currently pending in the application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 4, 10, and 12-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification fails to support the addition of an anionic direct dye in amounts that are outside the range of from 0 to 10%. Note that page 2 recites that the amount of the anionic direct dye is from 0 to 10%. Accordingly the lack of a specific amount of anionic direct dye is not supported by the specification as originally filed.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1731

5. Claims 4, 10 and 12-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 4 and 15 are confusing as written and therefore they are considered to be vague and indefinite as it is unclear as to the amount of water and anionic direct dye that may be added. Note that applicant has amended claim 4 and new claim 15 to recite "e) water to 100%, and an anionic direct dye". This phrase is confusing as it is unclear as to the amount of anionic direct dye that may be present and the amount of water to 100% that may be added since applicant first recites "water to 100%" and then recites that the composition also includes an anionic direct dye. Accordingly the claims are vague and indefinite as they fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 5-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luebke et al (US Patent No. 5,800,870 A) in view of Nagler (US Patent No. 3,784,596 A) for the reasons set forth in the previous office action and which are herein incorporated by reference.

Applicant argues that the instant claims are not obvious over the combination of references as there is no teaching, suggestion, motivation or other reason to combine the references because a person of ordinary skill in the art could not have predicted that the combination would be operable.

To this argument the examiner respectfully disagrees as it is believed that the motivation exists for one of ordinary skill in the art to utilize any type of pigment such as an organic pigment in the composition of the primary reference without producing any unexpected results as the primary reference states "others known in the art". The secondary reference teaches that inorganic or organic pigments may be useful in formulating compositions for coating papers and states, in column 6, lines 39+, that virtually any pigment or colorant, e.g. Quinacridone Red and Phthalocyanine Blue, or inorganic which can be prepared in finely divided form (having an average diameter of from about 0.2 to 5 microns) can be employed". Accordingly since the primary reference states that other pigments known in the art may be utilized to coat paper and the secondary teaches that virtually any pigment or colorant may be utilized to coat paper, one of ordinary skill in the art would find it obvious to utilize any pigment without producing any unexpected results absent evidence showing otherwise. The claims would have been obvious because "a person of ordinary skill has good reason to pursue the known options with his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense." Further, a predictable use of prior art elements according to their established functions to achieve a predictable result is *prima facie* obvious. See *KSR Int'l Inc. v.*

Art Unit: 1731

Teleflex Inc., 127 S Ct. 1727, 1741,82 USPQ2d 1385, 1396 (2007). That is, the use of a pigment to color a composition would appear to produce a predictable result in the absence of evidence showing otherwise. Accordingly since the applicant has not provided any convincing evidence that one of ordinary skill in the art would not have found it obvious to utilize other organic pigments for the pigments recited in the primary reference in light of the fact that the secondary reference suggests that both inorganic or organic pigments are useful to produce a coating composition for coating papers, the instant claims are obvious. Applicant needs to provide a proper showing that the use of the instantly claimed organic pigments produces unexpected results as compared to other known pigments in the coating compositions of the primary reference and until such time the rejection is proper and stands.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 1731

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is (571)272-1367. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry A. Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Anthony J Green/
Primary Examiner
Art Unit 1731

ajg
May 9, 2011